

U.S. Ser. No. 09/955,253
Applicants: Kreutz et al.

Auty. Dkt. B06090-D

REMARKS

Claims 50-60 and 74-77 are presented. Claims 50, 52, 53, 55 and 58 are independent. The present claims are supported by the embodiments and disclosure relating to Figs. 1-9.

Allowable Subject Matter:

The indication of allowability of claims 52, 53 and 55-59 is noted with appreciation. Thus, claims 52, 53, 55 and 58 have been rewritten in independent form. Dependent claims 74-75 have been added dependent from claim 52, and their additional subject matter is already present in claims 53-54. Dependent claims 76-77 have been added dependent from claim 53, and their additional subject matter is already present in pending claims 52 and 54. Thus, claims 52, 53, 55-59 and 74-77 are allowable.

Claims 50-51 rejected under §102(b) on Garenfeld EP 493 849 A1:

Claims 50-51 were rejected under 3102(b) on Garenfeld EP 493 849 since the Examiner asserted that the claim feature "protrusions" is met by the longitudinal sections between adjacent openings in plate 15.

Claim 50 is amended to recite that the claim feature "flexible protrusions" extend away from the carrier, for example are upstanding from the carrier. The claim now recites the additional feature that the protrusions have distal ends away from the carrier and proximal ends adjacent the carrier.

Garenfeld teaches a flat screen plate completely covering the depilation rollers and placed on the skin, as stated in col. 2, ln. 15, and a housing that vibrates while the screen remains in continuous contact with the skin. As this epilator/flat screen plate is pressed against the skin, hairs are ironed down and bent over rather than being grasped and plucked by the rollers, since the user always has to push the screen into continuous contact with the skin for the rollers 5,6 to have any chance at all to grasp hair. Inside housing 1 there is a first depilation member 3 consisting of counter-rotating rollers 5,6 and a second depilation member 4 having a second set of counter-rotating rollers 5,6. The screen plate 15 is pivotally mounted and has hair passage openings therethrough which prevent skin from being gripped by the rollers of the depilation member.

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The provision of upwardly extending protrusions to the Garenfeld screen would interfere with the intended operation of Garenfeld since they would space the hair-plucking rollers of Garenfeld even further from the skin. Thus, there is no motivation to modify Garenfeld to have protrusions with distal ends that are spaced from the carrier, and even if so modified, it would cause Garenfeld to be unsuitable for its intended purpose. It is also noted that there is no teaching or suggestion in Garenfeld that his screen plate is other than rigid; were it to be flexible, it would either deflect and cause fewer hairs to pass through into the rollers, or cause skin to enter and be pinched (and thus also no motivation to make it of resilient plastic as Examiner argued at page 4).

Applicants also refer Examiner to a Decision of the Board of Appeals in the prosecution of the Caric '182 patent, whose claims the present case had initially copied. While the pending claims of the present application have been amended slightly since the First Preliminary Amendment herein, the reasoning of this Decision of June 13, 2000 (see pages 5-6) is still pertinent insofar as Examiner would consider applying Garenfeld, and a copy of that Decision is attached hereto as an Appendix. In the First Preliminary Amendment in the present case it was noted that there the Board had reversed a §103 rejection, wherein the Examiner had alleged it would have been obvious to modify Garenfeld to have a plurality of flexible protrusions, since there was no motivation for any such modification in the prior art and, even if so modified, it would have caused the Garenfeld screen plate to be even further spaced from the skin and unsuitable for its intended purpose:

"[I]n that the provision of protrusions on the screen plate of Garenfeld would cause the screen plate, and thus the depilation members of the apparatus, to be spaced from the surface of the skin, it is unclear whether the apparatus of Garenfeld would still be suitable for its intended purpose if modified in the manner proposed by the examiner." See Decision at page 6.

Since amended claim 50 is believed allowable, its dependent claims 51, 54 and 60 are likewise allowable.

Since there were no other rejections, the claims are believed allowable and in condition for allowance. If Examiner would make any further objections, then prior to issuance of a further official action, it is respectfully requested that Examiner telephone the undersigned, who will endeavor to work with Examiner to resolve any outstanding issues in a phone conference.

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If a telephone conference would helpfully advance prosecution, the Examiner is invited to telephone the undersigned at 617-421-7939. Please apply any charges or credits to Deposit Account No. 07-1350.

Caric '182 Patent:

Applicant respectfully disagrees with and traverses the Examiner's remarks in the "Response to Arguments" section of the Office Action at pages 4-5, and repeats by incorporation herein the arguments previously presented in the Response filed May 20, 2003 at pages 10-17, and notes that the Examiner is in a position to review the matter with an interference specialist within his art unit.

Information Disclosure Statement:

Applicants file the RCE since they intend to shortly file an Information Disclosure Statement. Since this Response and RCE are being filed by facsimile transmission, the I.D.S. will follow subsequently.

Respectfully submitted,



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Appendix: Enclosed Board of Appeals Decision of June 13, 2000 in Caric '182 prosecution

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DRAZEN S. CARIC,
HERMANN JORDAN
and WOLFGANG J. OBERMANN

Appeal No. 1999-0180
Application No. 08/629,260

ON BRIEF

MAILED

JUN 13 2000,

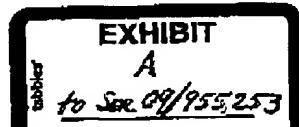
PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before CALVERT, ABRAMS and STAAB, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 2-5, 14-19 and 21. Claims 6-13 and 20, the only other claims pending in the application, have been withdrawn from consideration pursuant to 37 CFR § 1.142(b) as not being readable on the elected species. An amendment filed subsequent to the final rejection on July 11, 1997 (Paper No. 12) has been



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approved for entry by the examiner. See the advisory letter mailed July 28, 1997 (Paper No. 13).

Appellants' invention pertains to a depilation apparatus comprising a depilation member for gripping hairs on human skin and pulling the hairs from the skin. Claim 21, the sole independent claim on appeal, is illustrative of the appealed subject matter. A copy of claim 21 is found in an appendix to appellants' main brief.

The references of record relied upon by the examiner as evidence of obviousness are:

Sciple	919,649	Apr. 27, 1909
Garenfeld et al. (Garenfeld)	5,346,499	Sep. 13, 1994

Claims 2-5, 14-19 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Garenfeld in view of Sciple.¹

Reference is made to appellants' main and reply briefs (Paper Nos. 16 and 18) and to the examiner's answer (Paper No. 17) for the respective positions of appellants and the examiner regarding the merits of this rejection.

¹A rejection of claims 2-5, 14-19 and 21 under 35 U.S.C. § 112, second paragraph, made in the final rejection has been withdrawn. See Paper No. 13.

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Looking first at appellants' specification, it is explained on page 1 that in a known depilation apparatus,

the depilation member comprises a pair of cooperating rollers, while the vibration member comprises a screen plate which comprises hair passage openings and which prevents the skin from being gripped by the depilation member. The screen plate is pivotable with respect to the housing of the apparatus and is drivable by an electric motor of the apparatus into a pivoting oscillating movement. When the known depilation apparatus is placed on the skin to be depilated, the screen plate exerts mechanical vibrations on the skin. Said mechanical vibrations have an anaesthetizing effect on the skin, relieving pain sensations experienced when hair is being pulled from the skin by the depilation member.

A disadvantage of the known depilation apparatus is that the oscillating screen plate is comfortable on parts of the skin which overlie a relatively soft tissue and hence are relatively insensitive to mechanical vibrations, but rather uncomfortable on parts of the skin which closely overlie a bone and hence are relatively sensitive to mechanical vibrations.

An objective of appellants is to provide a depilation apparatus that is comfortable both on parts of the skin that closely overlie a bone and parts of the skin that overlie relatively soft tissue. To this end, appellants include a

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vibration member having flexible protrusions. As explained on page 2 of the specification,

(o)n parts of the skin which overlie a relatively soft tissue and hence are relatively insensitive to mechanical vibrations, the flexible protrusions are not bent so that the mechanical vibrations penetrate deeply into the skin and into the underlying tissue, and an adequate anaesthetizing effect is achieved. On parts of the skin which closely overlie a bone and hence are relatively sensitive to mechanical vibrations, the flexible protrusions are bent, so that uncomfortable mechanical vibrations of the bone underlying the skin are limited as far as possible.

Garenfeld, the examiner's primary reference, discloses a depilation apparatus 1 having a first depilation member 3 comprising a first set of counter rotating rollers 5, 6, and a second depilation member 4 comprising a second set of counter rotating rollers 5, 6. Garenfeld further includes a vibration member in the form of a pivotally mounted screen plate 15 having hair passage openings therethrough which prevent skin from being gripped by the rollers of the depilation members while allowing hair to pass through the openings to the rollers. The vibrations of the screen have an anaesthetizing effect on the skin to relieve pain sensations experienced when hair is being pulled from the skin. Column 2, lines 48-53. Thus, Garenfeld is akin to the known apparatus referred to by appellants on page 1 of the specification.

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In rejecting the appealed claims under 35 U.S.C. § 103, the examiner concedes that Garenfeld does not disclose flexible protrusions on the vibration member, as called for in independent claim 21. Nevertheless, the examiner considers that it would have been obvious to one of ordinary skill in the art to provide Garenfeld's vibration member with a plurality of flexible protrusion "since the flexible protrusions are notorious[ly] old and well known in the art for the comfortableness [sic] and easily transmitting [sic] vibration forces into the body" (answer, page 5).

We will not sustain this rejection.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). The mere fact that the prior art could be so modified in the manner proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the applied references simply would not have suggested the desirability, and thus the obviousness, of the proposed modification. In this regard, the examiner's rationale, quoted above, for providing

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flexible protrusions on the screen plate of Garenfeld in view of Sciple does not suffice. First, the test for obviousness is not what is "notorious[ly] old and well known in the art." Second, it is questionable whether Sciple teaches that prongs 23 increase comfort or facilitate transmission of vibration forces into the body, as implied by the examiner. In this regard, the only instance in Sciple where the prongs 23 are mentioned occurs on page 2, lines 6-10, wherein it is stated the applicator 22 "is molded or otherwise formed of rubber or other suitable elastic material, and is preferably provided with a plurality of projecting flexible prongs 23 for application to the body of the patient." In addition, in that the provision of protrusions on the screen plate of Garenfeld would cause the screen plate, and thus the depilation members of the apparatus, to be spaced from the surface of the skin, it is unclear whether the apparatus of Garenfeld would still be suitable for its intended purpose if modified in the manner proposed by the examiner.

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In light of the foregoing, it appears to us that the proposed modification of Garenfeld in view of Scipione is based on the use of impermissible hindsight knowledge derived from appellants' own disclosure, rather than on the fair teachings of the references.

The decision of the examiner is reversed.

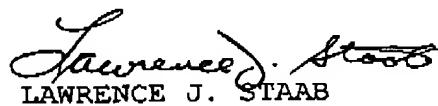
REVERSED



IAN A. CALVERT
Administrative Patent Judge



NEAL E. ABRAMS
Administrative Patent Judge



LAWRENCE J. STAAB
Administrative Patent Judge

) BOARD OF PATENT

) APPEALS AND

) INTERFERENCES

LJS:hh

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